

REMARKS

Claims 1-4 remain pending in the above-identified application, with claims 1-2 standing ready for further action on the merits, and claims 3-4 being withdrawn from consideration based on an earlier restriction requirement of the Examiner.

Claim Rejection -- 35 USC § 102(b)

Claims 1-2 have been rejected under the provisions of 35 USC § 102(b) as being anticipated by **Yamada et al. US '553** (US 4,491,553). Reconsideration and withdraw of this rejection is respectfully requested based on the following considerations.

Legal Standard for Determining Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegout Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipse dixit* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Voeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Liner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Supreme Court of the United States has recently held that the teaching, suggestion, motivation test is a valid test for obviousness, but one which cannot be too rigidly applied. See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ____, 82 USPQ2d 1385 (U.S. 2007). The Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, reaffirmed the Graham factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under Graham are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (U.S. 1966).

The Court in *KSR Int'l Co. v. Teleflex, Inc.*, *supra.*, did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Even so, the Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

Incorporation by Reference

Remarks set forth in the prior reply of December 27, 2005 are incorporated herein by reference in their entirety, since they support the patentability of each of pending claims 1-2 (*under consideration at present*) and claims 3-4 (*withdrawn at present*). As such, the Examiner is respectfully requested to review such remarks in their entirety at this time.

The Examiner is also respectfully requested to consider remarks set forth in the reply filed on September 21, 2006, and the earlier filed 37 CFR § 1.132 declaration of Mr. Kazuki TAKEMURA (that was filed with the reply of September 21, 2006). Said remarks and 37 CFR § 1.132 declaration are incorporated herein by reference in their entirety.

Enclosed 37 CFR § 1.132 Declaration

Enclosed with the instant reply is a 37 CFR § 1.132 Declaration of Mr. Yusuke KAWAMURA. The declaration contains therein comparative testing results that are material to a consideration of the patentability of claims 1-2 currently under consideration. The Examiner is thus respectfully requested to consider Mr. Kawamura's enclosed declaration at this time.

At pages 4-5 of the outstanding office action, the Examiner explains why the earlier submitted 37 CFR §1.132 Declaration of Mr. Kazuki TAKEMURA (that was filed with the reply of September 21, 2006) was insufficient to overcome the rejection of claims 1-2 over Yamada et al. US -553. In reply to such comments of the Examiner the following comments are particularly noted with regard to the instantly filed declaration of Mr. KAWAMURA:

- As to the Examiner's point of mixing procedure, filler, resin and PTFE emulsion are mixed all together at once in the Experiment 2 of Mr. Kawamura's enclosed declaration.
- As to the Examiner's point of PTFE content in the used PTFE emulsion, the Experiment 2 utilizes PTFE emulsion having PTFE content of 32%. (In Experiment 2 of Mr. Kawamura's Declaration, the 64% PTFE emulsion was utilized with being diluted double in advance with water.)
- As to the Examiner's point of composition, the composite of Mr. Kawamura's Experiment 2 contains 20 parts of aluminum hydroxide and 80 parts of resin, which is commensurate in scope with the scope of Yamada et al.
- As to the Examiner's point of mixing procedure of additives and molding temperature, Mr. Kawamura's Experiment 2 accords with Yamada et al.

- As to the Examiner's point of significance of the results, Mr. Kawamura's enclosed declaration shows the tensile strength of the Experiment 2, which was 4.1 MPa, and was much lower than 6.8 MPa of Example 1 of the present specification.

Accordingly, based on arguments previously presented and incorporated herein by reference, and the submission of the enclosed 37 CFR § 1.132 Declaration of Mr. Kawamura that is enclosed herewith, the Examiner is respectfully requested to reconsider and withdraw the outstanding anticipation rejection of record, inasmuch as such comments show that the cited art reference of Yamada et al. is incapable of anticipating any one of instant claims 1-2 or 3-4 or rendering any of the same instant claims 1-4 obvious. Any contention of the USPTO to the contrary must be reconsidered at present.

Request for Rejoinder of Claims 3-4

Upon allowance of pending claims 1-2, the Examiner is also respectfully requested to rejoin currently withdrawn claims 3-4.

Provisional Request for Interview

Should the instant reply not result in an allowance of each of instant claims 1-2, the Examiner is respectfully requested to contact the undersigned, John W. Bailey (Registry No. 32,881) in order to schedule an interview at the Examiner's earliest convenience, in order to further claims in the instant case to allowance. Mr. Bailey may be reached at the direct dial number of 703-205-8031 in the Washington, D.C. metropolitan area.

CONCLUSION

Based upon the remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of pending claims 1-2 are allowed and patentable under the provision of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: June 12, 2007

Respectfully submitted,

By 

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Enclosure: 37 CFR § 1.132 Declaration of Mr. Kawamura